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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/572,559	03/17/2006	Huan Huang	SHA 137NP	5077
23995	7590	01/29/2008	EXAMINER	
RABIN & Berdo, PC			MI, QIUWEN	
1101 14TH STREET, NW				
SUITE 500			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20005			1655	
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			01/29/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/572,559	HUANG, HUAN
	<b>Examiner</b>	<b>Art Unit</b>
	Qiuwen Mi	1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 3/17/06 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### **Claims Pending**

Claims 1-5 are pending. Claims 1-5 are examined on the merits.

### **Abstract Objection**

The abstract of the disclosure is objected to because an Abstract is not supposed to have a structure. Correction is required. See MPEP § 608.01(b).

### **Claim Rejections –35 USC § 112, 2<sup>nd</sup>**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The method in claim 5 does not comprise active steps. Rather, the method appears to reiterate experimental conditions that were previously published, as indicated by past tense verbs “was” or “were”. Since the required steps in the method cannot be determined, the claims is interpreted to encompass the following step to expedite examination prosecutions: the extracts of *Epimeredi indica* roots was diluted with water, filtered, and subjected to HPLC analysis.

**Claim Rejections –35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 USC § 102 (b) as being anticipated by Calis et al (Phytochemistry 23 (10): 2313-2315, 1984).

Calis et al teach a compound (2) isomarytynoside: 3-hydroxy-4-methoxy- $\beta$ -phenylethoxy-*O*- $\alpha$ -L-rhamnopyranosyl-(1-3)-6-*O*-feruloyl- $\beta$ -D-glucopyranoside, the same as formula I in claim 1 (see the entire document).

Therefore, the reference is deemed to anticipate the instant claim above.

**Claim Rejections –35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dharmasiri et al (Pharmaceutical Biology 40 (6): 433-439, 2002), in view of Arisawa et al (Planta Medica 38-41, 1986).

Dharmasiri et al teach that a decoction (water extract, oral liquid) of leaves and stems of *Anisomeles indica* (the same as *Epimeredi indica*, see the attachment) were orally administered to rats as an anti-inflammatory agent. Dharmasiri et al also teach that the two categories of plants were cut into small pieces and boiled separately in distilled water (200 g of plant material in 1000 ml of water) under reflux conditions, for 3 h. After 3 h, the boiled extracts were filtered through cotton wool and each filtrate was further reduced to 100 ml by boiling under reduced pressure. The concentrated extracts were then freeze-dried, were further reconstituted in distilled water (adjuvant) to obtain desired concentration in 1 ml solution during the treatment (thus oral solution) (page 433, right column, last paragraph; page 434, left column, 1<sup>st</sup> paragraph).

Dharmasiri et al do not teach root extract of *Anisomeles indica*, powder the roots, 10 times of water to extract twice, 1-2 h per time, concentration density, or 0.1-1.5% of compound epimeredinoside A through HPLC quantitative analysis.

Arisawa et al teach that “Fang Feng Cao” (the same as *Epimeredi indica*, see specification, page 1, 3<sup>rd</sup> paragraph) is the dried whole plant of *Anisomeles indica*. The crude drug has bee used in China for antidote, stomachache, pain, boil, swelling, poles and hypertension.

Therefore, it would have been *prima facie* obvious for one of ordinary skill in the art at the time the invention was made to use the root of *Epimeredi indica* in the decoction of Arisawa et al since Arisawa et al teach that the whole plant (thus including root) of *Anisomeles indica* has been used in China for antidote, stomachache, pain, boil, swelling, poles and hypertension. Since both of the references teach the use of plant *Epimeredi indica*, one of ordinary skill in the art would have been motivated to make the modifications. Water extract of root *Epimeredi indica* would inherently contain compound epimeredinoside A. Regarding the limitation to the amount of water used in the extraction process, extraction time, concentration density, or HPLC quantitative analysis to determine the concentration of a component, the result-effective adjustment in conventional working parameters is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan. It is well known in the art to powder the plant material to increase the surface area so as to enhance solvent extraction efficacy.

From the teachings of the references, it is apparent that one of the ordinary skills in the art would have had a reasonable expectation of success in producing the claimed invention.

Thus, the invention as a whole is *prima facie* obvious over the references, especially in the absence of evidence to the contrary.

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### Conclusion

No claim is allowed.

Art Unit: 1655

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qiuwen Mi whose telephone number is 571-272-5984. The examiner can normally be reached on 8 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on 571-272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Qiuwen Mi



CHRISTOPHER R. TATE  
PRIMARY EXAMINER